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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,099	02/02/2004	Makarand S. Shinde	FACT-01008US1	2047
23910	7590	06/27/2005	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			CHAN, EMILY Y	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/771,099	Applicant(s) SHINDE ET AL.	
	Examiner Emily Y. Chan	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 26-31, 43-46 and 50-53 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 26-31 and 43-46 is/are allowed.
6) ☒ Claim(s) 1-11, 14-16 and 50-53 is/are rejected.
7) ☒ Claim(s) 12 and 13 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added features that “without electrically connecting to the probe contacts” and that “support means contacts the second side of the substrate” are not described in the specification.

Claim Objections

2. Claims 1 and 50 are objected to because of the following informalities: the claim language recited in claims 1 and 50 are unclear because in claim 1, the support means is recited “without electrically connecting to the probe contact” whereas in its dependent claim 50, the support means is recited to “contacts’ the second side of the substrate “. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Eldridge et al US Patent No. 6,483,328.

Eldridge et al ('328) is applied to claim 1 for the same reason as stated in the previous office action dated on 1-25-05.

Claims 1-4, 6-12 , 14-15, and 50-53 are rejected under 35 U.S.C. 102(b) as being anticipated by the applicants' admitted prior art (see Fig. 2).

The applicant's admitted prior art is applied to claims 1-4, 6-12 and 14-15 for the same reason as stated in the previous office action dated on 1-25-05.

With respect to the newly added claims 50 – 53, the applicant's admitted prior art discloses (see Fig. 2) that the support means contacts the second side of the substrate within a defined area and the probe card comprising a plate attached to a printed circuit board (30). Note, applicants admit that the probe card of Fig. 3 of the instant invention which applicant claims invention, includes components providing electrical pathways, similar to the conventional probe card of Fig. 2 (see page 11 paragraph (0038) of the specification).

Therefore, the applicants' admitted prior art (see Fig. 2) anticipate the new added claims 50 - 53.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over by applicants' admitted prior art (Figs. 1-2) in view of Khandros et al US Patent No. 6,690,185.

Applicants' admitted prior art (Figs. 1-2) in view of Khandros et al ('185) is applied to claims 5 and 16 for the same reason as stated in the previous office action dated on 1-25-05.

Response to Arguments

5. Applicant's arguments filed 5-4-05 have been fully considered but they are not persuasive. Applicant argued that (1) claim I has been amended to claim a "support means positioned against a second surface of the substrate substantially opposite said probe contacts without electrically connecting to the probe contact" and that the support means (335) of Eldridge ('328) make electrical contact with probe contacts, and (2) the support means is claimed to be positioned "substantially opposite said probe contacts." and applicant's Fig. 2, however shows the supports identified in the Office Action (particularly 66) that are not substantially opposite the contacts 16.

With respect to applicant's argument (1) above, the examiner disagrees with applicants' assertion because the support means (335) of Eldridge ('328) is inherently supported by a mechanical means and the mechanical means of Eldridge ('328) would meet the claimed support means in the amended claim 1.

With respect to applicant's argument (2) above, it should be pointed out that applicants admitted in the instant specification (see page 11, paragraph (0036)) that the probe card of Fig. 3 of the instant application is similar to the conventional probe card of

Fig. 2. Therefore, all the claimed structural limitations (i.e., a substrate, a probe card, an electrical connection means and support means) are anticipated by the conventional prior art of Fig. 2. Note, the five components: (1) a frame having an increased length horizontal extension, (2) leaf springs with bends, (3) an insulating flexible membrane, (4) additional support structure and (5) a highly rigid interface tile id provided between the probes and a lower flexural strength space transformer substrate that applicants set forth on page 11 of the specification as invention are not recited in claims 1-4, 6-12, 14-15, and 50-53.

Allowable Subject Matter

6. Claims 26-31 are allowed over the prior art.
7. Claims 12-13 and 43-46 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The reason reasons for the indication of allowable subject matter are stated in the previous office action dated on 1-25-05.

Response to Amendment

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Y. Chan whose telephone number is 571-272-1956. The examiner can normally be reached on 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 571-272-2034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EC
6-13-05


VINH NGUYEN
PRIMARY EXAMINER
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06/22/05